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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/608,183

06/30/2003

Karp-Sik Youn

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EXAMINER

HUFFMAN, JULIAN D

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/608,183	YOUN, KARP-SIK	
	Examiner	Art Unit	
	Julian D. Huffman	2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-11 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. Applicant's remarks concerning the priority claim have been considered. The oath claims foreign priority to the 2002-07401 application and a certified copy of the document has not been received. In light of applicant's remarks, it is clear that applicant is waiving this priority claim. Therefore the sole priority claim is to the 2002-37461 application. However, the oath must be corrected.

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 and 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson et al. (U.S. 5,527,123).

Jackson et al. disclose an apparatus to control static electricity in an ink-jet printer, comprising:

- a print head (103);

- a paper-feeding portion from which paper is fed (column 3, lines 56-60);

- a feeding roller (114) to convey the paper being fed from the paper-feeding portion to the print head;

- a pinch roller (180) to rotate in contact with the feeding roller, the pinch roller having a shaft;

- a holder (188), the shaft of the pinch roller being rotatably supported on the holder;

- a frame (186) made of a metallic material (column 4, lines 44-47), to support the holder; and

- a ground member (191) to ground the pinch roller to the frame, to control the static electricity occurring in the paper passing between the feeding roller and the pinch roller. Element 191 is a metal spring connecting the roller to the metal frame and thus is capable of grounding the roller to the frame and controlling static electricity.

With regards to claim 2, the ground member is connected to the shaft of the pinch roller and the frame (fig. 2).

With regards to claim 3, the ground member is a metallic wire that has a first end connected to the shaft of the pinch roller and a second end connected to the frame (element 191 is a thin piece of metal and therefore may be called a wire).

With regards to claim 4 the ground member is a torsion spring (spring reacts against twisting motion) that is disposed around the frame and has a first end elastically contacting the pinch roller and a second end elastically contacting the frame (column 5, lines 19-26).

With regards to claim 9, Jackson et al. disclose a plurality of the ground members, one for each pinch roller (fig. 1).

With regards to claim 11, the limitations directed towards static electricity being generated in the printing medium and being removed from the printing medium do not limit the apparatus claims since they do not provide additional structure. The recording medium with static charge does not limit the claimed apparatus since the material or article worked upon by an apparatus does not further limit the apparatus, see MPEP 2115.

4. Claims 1, 2, 6, 7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Saito et al. (U.S. 5,805,176).

Saito et al. disclose an apparatus to control static electricity in an ink-jet printer, comprising:

- a print head (60);

- a paper-feeding portion from which paper is fed (10);

- a feeding roller (30) to convey the paper being fed from the paper-feeding portion to the print head;

- a pinch roller (40) to rotate in contact with the feeding roller, the pinch roller having a shaft;

a holder (fig. 3, element 41), the shaft of the pinch roller being rotatably supported on the holder;

a frame (90) made of a metallic material (if frame were not made of metal, device could not be grounded), to support the holder; and

a ground member (48) to ground the pinch roller to the frame, to control the static electricity occurring in the paper passing between the feeding roller and the pinch roller (column 7, line 61-column 8, line 2). Element 191 is a metal spring connecting the roller to the metal frame and thus is capable of grounding the roller to the frame and controlling static electricity.

With regards to claim 2, the ground member is connected to the shaft of the pinch roller and the frame (ground member 48 is attached to shaft 40a).

Allowable Subject Matter

5. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record does not disclose, in the combination, the pinch roller including a conductive synthetic resin.

Response to Arguments

6. Applicant's arguments have been considered and have been deemed non-persuasive.

Applicant argues that the leaf springs 188 of Jackson do not correspond to the claimed holder. Applicant states that the pinch wheels 180 are not supported on the leaf springs. However, this limitation is never claimed. The claims state that the shaft of the pinch roller is supported on the holder. The leaf spring 188 supports the underside of the shaft of the pinch roller and also supports the pinch rollers which are connected to the shaft. The leaf spring need not contact the pinch rollers, nor is it claimed that the holder contacts the pinch rollers.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that Jackson does not disclose a ground member to ground the pinch roller to the frame. Applicant states that the pinch finger 191 is not equivalent to a frame and that the pinch finger is a part of element 186. The claim language recites “a frame... to support the holder”. Element 191 supports the holder 186 and is a frame. The claim language does not prohibit the frame and holder from being portions of the same structure. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that the torsion spring of Jackson is not disposed around the frame. The torsion spring is disposed in the vicinity of the frame and therefore is disposed around the frame. The examiner is required to give the claims their broadest reasonable interpretation. The term around does not require the spring to completely surround the torsion spring. Applicant has not used the language “the torsion spring is

wrapped around the frame”, which is used in the specification at section 0022 to describe the structure. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant has not presented arguments regarding the rejection of claims 1, 2, 6, 7 and 11 as being anticipated by Saito, or amended to overcome the rejection. Therefore this rejection is deemed proper and maintained.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian D. Huffman whose telephone number is (571) 272-2147. The examiner can normally be reached on 9:30a.m.-6:00p.m. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JH
18 February 2005



Thinh Nguyen
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